

REMARKS/ARGUMENTS

This present Response is being filed in reply to the Office Action dated October 20, 2006. Applicants hereby request a one-month extension of time to extend the period of response to and including February 20, 2007.

By the present amendment, claims 1, 11, and 16 have been amended. Claims 1-8 and 10-16 are pending in the application. No new matter has been added. Support for the claim amendment can be found throughout the specification and drawings as originally filed. See, for example, FIGS. 1-2 and paragraph 49. The amendment of the claims is being made solely to expedite prosecution of the above-identified patent application. Applicants reserve the option to further prosecute the same or similar claims in the present or subsequent patent applications.

Rejection of Claims 1-8 and 10-16 under 35 U.S.C. § 102(b)

The Office Action rejected claims 1-8 and 10-16 under 35 U.S.C. § 102(b) as being anticipated by Fiore (U.S. Patent No. 3,815,585). The Office Action rejected claims 1-8 and 10-16 under 35 U.S.C. § 102(b) as being anticipated by Pestka (U.S. Patent No. 3,650,266). Applicants respectfully traverse these rejections for the reasons set forth below.

Independent claims 1, 11, and 16 are directed to a retractor blade assembly comprising a fixed blade and adjustable blade operatively coupled to the fixed blade. Claims 1, 11, and 16 have been amended to clarify that the adjustable blade is linearly adjustable relative to the fixed blade parallel to longitudinal axis of the tissue retracting segment of the fixed blade. Claims 2-8 and 10 depend from claim 1 and claims 12-15 depend from claim 11.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Neither Fiore nor Pestka expressly or inherently describe a retractor blade assembly having an adjustable blade that is linearly adjustable relative to the fixed blade parallel to the longitudinal axis of the tissue retracting segment of the fixed blade, as recited in claims 1, 11, and 16. Fiore describes a speculum having a pair of interconnecting frame members 11 and 12 that provide for elevational adjustment and angular adjustment of two tissue retracting duckbills 15 and 18. See Column 3, lines 48-58, of the reference. Elevational adjustment

and angular adjustment are not linear adjustment. Fiore fails to disclose that the adjustable duckbill, duckbill 18, is linearly adjustable parallel to the longitudinal axis of the fixed duckbill, duckbill 15. Moreover, duckbill 18 is not capable of linear adjustment parallel to the longitudinal axis of duckbill 15 as the duckbill 18 is limited to elevational adjustment within the channels formed by the arms 24, 25 of the frame 11 and pivotal adjustment about the notch 35.

Likewise, Pestka describes a speculum having a fixed lower tissue retracting jaw 12 and an upper tissue retracting jaw 16 that is pivotally adjustable relative to the fixed jaw 12 and may be separated from the fixed jaw 12. See Column 1, lines 62-75 and Column 2, lines 1-22. Pivotal adjustment and separation are not linear adjustment. Pestka fails to disclose that the upper jaw 16 is linearly adjustable parallel to the longitudinal axis of the lower jaw 12. Moreover, the upper jaw 16 is not capable of linear adjustment parallel to the longitudinal axis of the lower jaw 12 as the upper jaw 16 is limited to pivoting about the pivot pin 18 and separation from the lower jaw 12 by movement within slot 14b, which is not oriented parallel to the longitudinal axis of any segment of the lower jaw 12. Rather, the slot 14b is oriented generally parallel to the longitudinal axis of the handle 14. Handle 14 does not include a tissue retracting segment as it is a handle designed to be grasped by the users hand and allow manipulation of the dilating jaws 12 and 16.

The Office Action cites a number of cases in support of the rejection of the claims under 35 U.S.C. § 102(b). Applicants respectfully disagree with the applicability of the cases to present claims. The Office Action repeatedly states:

“With regard to the statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Fiore [and Pestka], which is capable of being used as claimed if one desires to do so. In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963)”

and

“Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed

structural limitations. *Ex Parte Marsham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)”

Claims 1, 11, and 16 recite the structural relationship of two components of the claimed apparatus. The claimed apparatus, a retractor blade assembly, comprises a first component, a fixed blade, and a second component, an adjustable blade. Claims 1, 11, and 16 further recite the structural relationship between the two components – the adjustable blade is operatively coupled to the fixed blade and linearly adjustable relative to the fixed blade parallel to the longitudinal axis of the tissue retracting segment of the fixed blade. This relationship is not a statement of intend use. Nor is it a functional statement. It is a structural relationship between to components of the claimed invention. Thus, to anticipate claims 1, 11, and 16, the prior art reference must disclose, expressly or inherently, this structural relationship. Fiore and Pestke do not disclose this relationship and therefore do not anticipate claims 1, 11, and 16.

The Office Action further states:

“Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983).”

In *Kalman*, the Appeals Court noted that the district court incorrectly emphasized that “[t]o be an anticipation a prior patent must include all the teachings necessary to accomplish what the allegedly invalid *patent* succeeds in doing. (Emphasis ours.)” *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781 (Fed. Cir. 1983). The Appeals Court pointed out that the district court’s analysis

“was a somewhat incorrect analysis of the law of anticipation, which requires that a distinction be made between the invention described or taught and the invention claimed. The law of anticipation does not require that the reference “teach” what the subject patent teaches. Assuming that a reference is properly “prior art,” it is only necessary that the claims under attack, as construed by the court, “read on” something

disclosed in the reference, *i.e., all limitations of the claim are found in the reference, or "fully met" by it.*" *Id.* (emphasis added)

Despite the error, the Appeals Court went on to affirm the district court's ruling that the claim at issue was not anticipated because the district court found that *one element of the claimed invention was not disclosed in the prior art reference.* *Id.*

In the present application, Applicants do not argue that Fiore and Pestke fails to disclose the invention described or taught in the application (although, in fact, the references do not disclose the invention described or taught in Applicants' application). Applicants' arguments are directed to the specific claim language of independent claims 1, 11, and 16. To be clear, Fiore and Pestke fail to disclose, expressly or inherently, at least one element of the claimed invention recited in independent claims 1, 11, and 16, namely, that the adjustable blade is linearly adjustable relative to the fixed blade parallel to longitudinal axis of the tissue retracting segment of the fixed blade. This claim element is clearly recited in each of these independent claims. Fiore and Pestke do not disclose this claim element and therefore do not anticipate claims 1, 11, and 16.

Conclusion

In view of the remarks set forth above, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with the Applicants' attorney would be helpful in expediting the prosecution of the application, the Examiner is invited to call the undersigned at (508) 880-8488.

Respectfully submitted,

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